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Art Unit 338

AUG 23 1991

Paper No. 17

Appeal No. 91-2492

BOARD OF PATENT APPEALS
& INTERFERENCES

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ON BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Don A. Perry
and
Earl Wright

Application filed April 13, 1989, Serial No. 337,253,
for the Reissue of Patent No. 4,657,021, granted April 14, 1987,
based on application Serial No. 726,767, filed April 24, 1985.
Touch Enhancing Pad.

Philip L. Bateman for appellants.

Examiner - Randy Shay

Before McCandlish, Meister and Staab, Examiners-in-Chief.

Meister, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1-12, the only claims remaining in the application. Claims 1-11 correspond to the original patent claims.

The appellants' invention pertains to an apparatus which enhances the sense of touch the nature of which is readily discernable from a perusal of claim 12 which reads as follows:¹

12. An apparatus which enhances the sense of touch when placed between the fingertips of the user and object being touched, the apparatus consisting essentially of:

- (a) a sealed enclosure formed from two pieces of a pliable, elastic material having a wall thickness of about 0.005 to 0.020 inches, a modulus at 300 percent elongation of less than about 1,500 psi, a tensile strength of greater than about 3,000 psi, and an ultimate elongation of greater than about 400 percent so that the enclosure is resistant to tearing or puncturing and which is adapted to conform to the contours of the object being touched and to readily transmit touch stimuli; and
- (b) a liquid lubricant inside the enclosure which has sufficient lubricity to reduce the coefficient of kinetic friction between the interior walls of the enclosure by at least about 60 percent so that the bottom wall of the pad remains stationary over the object being touched while the top wall moves freely with the fingertips, a sufficiently-high resistance to mass transfer through the enclosure so that the amount of lubricant inside the enclosure remains substantially constant over time, substantial inertness towards the enclosure, and which is present in an amount sufficient to fully coat the interior of the enclosure, provided that

¹ We note that claim 12 as it appears in the amendment filed April 26, 1990 (Paper No. 8) is not in proper reissue format. See 37 CFR 1.121(e) and M.P.E.P. 1411. In our view, the appellants should have presented a new claim 14 which was fully underlined and which included all of the desired amendments to claim 12. The amendment of newly presented reissue claims using bracketing and underlining, which would normally be used in amending a pending claim, is not permitted in reissue practice. For the sake of at least partially complying with the proper reissue claim format, we have underlined claim 12 in its entirety.

the amount of the liquid lubricant permits the enclosure to be flattened with at least about 75 percent of the surface area of one wall in contact with the other wall with only a minimum layer of lubricant between the walls.

The references of record relied on by the examiner are:

Paschal	2,694,396	Nov. 16, 1954
Beck (Germany)	645,391	May 5, 1937
(Translation copy attached)		

Claims 1-12 stand rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. The answer states that (pages 1 and 2):

... The first issue is not just whether the declaration is defective because the discovery of the error was made as a result of commercial activity which occurred after the original patent had issued, but rather whether language in [the] claims in the original application which would have covered this embodiment but was specifically canceled from the claims in the original application in order to read over the prior art can be recaptured, as Appellants attempt to do here.

The answer also states that (page 3):

The reissue declaration filed with this application is defective because it states that the discovery of the error was caused by the development of a new embodiment after the patent had issued. The purpose of a Reissue Application is to correct errors that occur during prosecution, not to cover newly developed embodiments which would have been covered by claims in the original application.

Claim 12 stands rejected under 35 U.S.C. 103 as being unpatentable over Paschal in view of Beck. According to the

examiner it would have been obvious to utilize rubber as the elastic material in Paschal in view of the teachings of Beck. It is also the examiner's position that (answer, page 4):

To select any particular rubber known at the time of Appellants' invention based on its known properties, including one meeting the property limitations claimed in claim 12 would have been an obvious matter of design choice at the time of Applicants' invention.

Rather than reiterate the conflicting viewpoints advanced by the appellants and the examiner in support of their respective positions, reference is made to the brief, reply brief and answer for the full exposition thereof.

OPINION

We have carefully reviewed the record before us, including each of the arguments and comments advanced by the appellants and by the examiner in support of their respective positions. This review leads us to conclude that the examiner's position is not well founded. Accordingly, we will not sustain either of the above-noted rejections.

We consider first the rejection of claims 1-12 under 35 U.S.C. 251 as being based upon a defective reissue declaration. Although we are in agreement with the examiner that claims 1-12 are in fact based upon a defective reissue declaration for the reasons set forth *infra* in our new rejection entered under the

provisions of 37 CFR 1.196(b), we nevertheless cannot sustain the examiner's rejection on this ground inasmuch as our reasoning in arriving at this determination is different from that of the examiner. See *In re Waymouth*, 486 F.2d 1058, 179 USPQ 627 (CCPA 1973).

The main thrust of the examiner's position appears to be that the appellants are attempting to recapture subject matter which had been canceled from the original application. We cannot agree. As the court in *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984) stated at 221 USPQ 295:

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after grant of the original patent. (emphasis in original -- citations omitted)

Here, the appellants disclosed two species in the original application (a first species wherein the enclosure was formed from "a single piece" of material and a second species wherein the enclosure was formed from "a plurality of pieces" of material -- see patent, column 3, lines 50-54). Independent claim 1 of the original application, as originally presented, did not specify the number of pieces from which the enclosure was

made and therefore only generically claimed these two embodiments. In response to the examiner's final rejection in the original application, independent claim 1 was amended to specify, *inter alia*, that the enclosure was made from a single piece of material (i.e., the first species), whereupon the original application was allowed. In the present reissue application, independent claim 12 is identical to independent claim 1 of the patent with the exception that it sets forth that the enclosure is made from a plurality of pieces of material (i.e., the second species) rather than from a single piece of material. It is thus clear that independent claim 12, although generally of the same scope as claim 1 of the patent, is narrower in scope than the generic subject matter which was "canceled" from the original application and therefore the "recapture rule" has not been violated.

As to the examiner's contention that the purpose of the reissue application is "not to cover newly developed embodiments which would have been covered by claims in the original application," we note that notwithstanding the fact that the embodiment of claim 12 was commercialized after the issuance of the patent (note *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984)), the appellants clearly disclosed in the original application a species wherein the enclosure was made from a "plurality of pieces" and where, as here:

...the overall disclosure reasonably conveys to one skilled in the art that the inventor had possession of the broad invention at the time the original application was filed a claim drawn to that invention is available upon compliance with all provisions of §252. See *In re Peters*, 723 F.2d 891, 221 USPQ 952 (Fed. Cir. 1983)

In view of the foregoing, we will not sustain the examiner's rejection of claims 1-12 under 35 U.S.C. 251.

Turning now to the rejection of claim 12 under 35 U.S.C. 103 as being unpatentable over Paschal in view of Beck, even if we were to agree with the examiner that it would have been obvious to utilize rubber as the elastic material in the device of Paschal in view of the teachings of Beck, we cannot agree that it would have been an obvious matter of design choice to have selected a "known" rubber having the claimed parameters. As set forth on page 3 of the specification, rubber having these parameters "is strong enough to resist tearing or puncturing and yet thin enough to readily transmit touch stimuli," and therefore we are not of the opinion that the selection of such a material can be dismissed as an obvious matter of design choice. Compare, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Since we do not find that the examiner has established a *prima facie* case of obviousness, we need not consider the appellants' evidence of nonobviousness. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596

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(Fed. Cir. 1988). Accordingly, we will not sustain the examiner's rejection of claim 12 under 35 U.S.C. 103.

Under the provisions of 37 CFR 1.196(b) we make the following new rejection.

Claims 1-12 are rejected under 35 U.S.C. 251 as being based upon a defective reissue declaration since there is nothing in the original patent evidencing that the appellants intended to claim an invention involving the species wherein the enclosure was made from two pieces of material. As we have noted above, the appellants in the original application disclosed a first species wherein the enclosure was formed from "a single piece" of material and a second species wherein the enclosure was formed from "a plurality of pieces" of material. It is also of significance to note that, although the appellants' overall disclosure might reasonably convey to the artisan, as a broad proposition, that the inventor had in his possession at the time the original application was filed a species having two pieces (see *In re Peters, supra*), a two-piece enclosure was never specifically mentioned in the original application, but instead reference was made therein to the enclosure being made from "a single piece" or "a plurality of pieces." As we also have noted above, the claims of the original application, as filed, were generic in that they did not specify the number of pieces from which the enclosure was made but were amended subsequent to final rejection to specify

that the enclosure be formed of a single piece. There is simply nothing in the original patent to suggest that the appellants intended to claim a species wherein the enclosure was made from two pieces of material. As the court in *U.S. Industrial Chemicals, Inc. v. Carbide and Carbon Chemicals, Corp.*, 315 U.S. 668, 676, 53 USPQ 6, 9-10 (1942):

...it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered.

In the present case, not only is there nothing in the original patent which would lead one to believe that the appellants intended to claim the species now being claimed, but the amended reissue declaration expressly states that:

At the time the patent application which matured into the Patent was filed, we believed the preferred enclosure was a single piece of natural latex rubber....and although original Claim 1 did not recite the number of pieces in the enclosure, we expected the commercial product to be made of a single piece of natural latex rubber.

It is thus clear to us from this declaration that there was no intent on the part of the appellants to claim the species having an enclosure made from a plurality of pieces in the original application.

Where, as here, the appellants make a disclosure of two species, claim one, and ignore the other,

...it is difficult to find error in the failure to claim...[the one]...ignored on the sole basis...[it was]...disclosed. To so hold would render meaningless the statutory requirement that an appellant point out and distinctly claim subject matter he regards as his invention. 35 U.S.C. §112.... See *In re Weiler*, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986)

From our perspective, the omission of a species having an enclosure made of two pieces from the claimed subject matter of the original application does not constitute "error" under §251.

In summary:

The examiner's rejection of claims 1-12 under 35 U.S.C. 251 as being based on a defective reissue declaration is reversed.

The examiner's rejection of claim 12 under 35 U.S.C. 103 is reversed.

A new rejection of claims 1-12 under 35 U.S.C. 251 as being based on a defective reissue declaration is made.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory

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period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

REVERSED
37 CFR 1.196(b)

Harrison E. McCandlish
Harrison E. McCandlish
Examiner-in-Chief)

James M. Meister
James M. Meister
Examiner-in-Chief)

Lawrence J. Staab
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TELEVISION - U.S. AND INTERNATIONAL

ABC-TV, HOME - DECEMBER 19, 1988
SYNDICATED, DR. DEAN EDELL'S MEDICAL REPORTS - OCTOBER, 1988
SYNDICATED, DR. BOB LANIERE'S 60-SECOND HOUSE CALLS - APRIL, 1989
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WFED-TV/FOX	SAN FRANCISCO, CA
BOSTON, MA	KGO-TV/ABC
WCVB-TV/ABC	MILWAUKEE, WI
WNEV-TV/CBS	WITI-TV/CBS
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KTVY-TV/ABC	

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THE NEWARK STAR-LEDGER - MAY 14, 1989
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